

REMARKS

This is in response to the Advisory Action mailed September 27, 2008, and is further in response to the Official Action of April 9, 2008. This response is being filed with a Request for Continued Examination and the appropriate fee and/or applicants' instruction to charge the appropriate fee to the Deposit Account of Applicants' attorney. Applicants request reconsideration and entry of the Response filed August 27, 2008, and the accompanying Declaration of Gary David Fisher.

The Advisory Action incorrectly asserts that "gilsonite is asphalt, as evident by 'Wikipedia' obtained from distillation of natural crude oil. Hence, gilsonite is an oil, or at least fraction of oil, and in view of the broad unspecified disclosure, the gilsonite disclosed by the reference is gilsonite oil, and gilsonite itself inherently contains gilsonite oil."

Applicants contest and traverse the rejection, at least in part, in that the Wikipedia entry, insofar as it has been properly cited, does not constitute either prior art or a reliable or authoritative resource. Assuming only for the sake of argument that such a reference could be deemed authoritative and/or reliable, the Advisory Action incorrectly characterizes the reference and draws unsupported conclusions from it. In fact, and as discussed more below, the Wikipedia entry supports Applicants' position.

Submitted herewith are references describing and characterizing Gilsonite, which is also known as uintahite and/or uintaite.

The assertion that Gilsonite is "obtained from distillation of natural crude oil" incorrectly characterizes the cited Wikipedia entry; but more importantly, is

contradicted by the more authoritative references submitted herewith and/or cited herein.

In the "Academic Press Dictionary of Science and Technology" (Ed. Christopher Morris; Academic Press, Harcourt Brace Jovanovich, 1992) Gilsonite is defined as "a very brittle, jet black variety of asphaltite having a conchoidal fracture, a specific gravity of 1.05 to 1.1, and a hardness of 2 to 2.5 on the Mohs scale..." (copy enclosed). Gilsonite is thus not an oil, but a very brittle solid.

The Kirk-Othmer Encyclopedia of Chemical Technology likewise supports Applicants' contention (copy enclosed). Kirk-Othmer Encyclopedia of Chemical Technology, Kirk, R.E. & Othmer, D.E., Eds., The Interscience Encyclopedia, Inc., New York, (1948). The Kirk-Othmer states clearly that Gilsonite has a softening point of 270-400°F, and has other physical characteristics that would lead one of ordinary skill in the art to conclude that Gilsonite is a solid, and not an oil.

Additionally, the Kirk-Othmer states that Gilsonite is a unique asphaltite. For example, "It is one of the purest, natural bitumens known." And further, "gilsonite, unlike almost all other petroleum or nature asphalts, can mix in almost any proportion with waxes to form stable compounds." Thus, the reference makes clear that Gilsonite is a solid, and is distinguishable from all other natural bitumens or natural asphalts. One of ordinary skill in the art would have understood and expected that the properties of Gilsonite, and its various derivatives, would likewise have distinct properties compared to other asphalts.

As stated above, the Advisory Action improperly relies upon Wikipedia, which is generally recognized as not an authoritative resource. *See, e.g.*, Law.com, "The Patent Office: Getting Wiki With it",

<http://www.law.com/jsp/law/LawArticleFriendly.jsp?id=900005552941>, October 9, 2008. To the extent that the rejection relies upon that reference at all, it is improper and should be withdrawn.

But just as importantly, Wikipedia actually supports Applicants' contention. The Wikipedia entry for Gilsonite states "It is mined in underground shafts and resembles shiny black obsidian." (<http://en.wikipedia.org/wiki/gilsonite>, October 7, 2008). Additionally, the Gilsonite entry references a footnote to Mindat (<http://www.mindat.org/min-4083.html>) wherein an image of Gilsonite shows a solid black material similar in appearance to coal or black obsidian.

As one of skill in the art would appreciate, obsidian is "a naturally occurring glass formed as an extrusive igneous rock." Wikipedia (<http://en.wikipedia.org/wiki/Obsidian>). And, as with obsidian, Gilsonite is a solid. *See, id.* ("Obsidian was valued in the Stone Age cultures because, like flint, it could be fractured to produce sharp blades or arrowheads.").

Further, resort to the internet site Answers.com™ refers back to the Wikipedia entry for Gilsonite but adds to the description. Notably, the entry states "Uintaite is a glossy, black, solid hydrocarbon resin similar in appearance to coal or hard asphalt. It is brittle and lightweight and can be easily crushed into powder." *See* <http://www.answers.com/topic/gilsonite>, 10/7/2008.

It is also notable that the Answers.com entry also states: "Some Iranians maintain that there are some mines in Kermansha, Iran that have been discovered and extracted for some years. However, the materials found in Iran are not uintaite and are chemically different in several important ways. The minerals found in Iran are a different asphaltite from the uintaite mineral found in Utah." Thus, Gilsonite is

a solid material similar in appearance to coal, hard asphalt, or obsidian, and that although there is similarity between this material and other asphaltites, there are important chemical distinctions between various ores of asphaltites. Accordingly, one of ordinary skill in the art would have readily understood and appreciated that various forms of asphaltite have distinct properties and chemical characteristics, and that those materials would likewise yield distinct derivative materials such as oils extracted from them. *See also* "Earth Science World Image Bank", <http://www.earthscienceworld.org/images/search/results.html?Keyword=bitumens> (10/7/2008).

The plain teachings of the references cited above, including the cited Wikipedia entry, make plain that Gilsonite is a solid, and is not "obtained from distillation of natural crude oil." Moreover, it is a unique material. Although it is among the class of asphaltite minerals or mineraloids, it possesses "important chemical distinctions" from other asphaltites. One of skill in the art would readily appreciate that Gilsonite is a solid - not an oil - and that it is therefore something entirely distinct from Gilsonite oil.

Further, the Fisher Declaration, presented with the previous Response and now entitled to due consideration, thoroughly supports applicants' contention. The Declaration is evidence that "Gilsonite oil is quite distinct from Gilsonite", and that "it is distinct from the combination of Gilsonite and mineral oil". Fisher Declaration, ¶ 3. No evidence has been presented supporting an alternative contention or disputing that fact.

The Declaration also establishes that:

Gilsonite is a shiny, black solid substance similar in appearance to the mineral obsidian; it is brittle and can be easily crushed into a dark

brown powder. Gilsonite melts at temperatures in the range of 250°F to 400°F. Gilsonite is soluble in aliphatic, aromatic and chlorinated hydrocarbon solvents. It has limited solubility in most ketones, but is soluble in mixed aromatic solvents that contain a ketone component. Gilsonite is not soluble in water, alcohols, or acetone. Gilsonite oil, however, is a clear to brown liquid with a viscosity generally ranging from 2 to 100 centipoises at 77°F (slightly more viscous than water), and it is miscible in non-polar solvents, generally.

Fisher Declaration, ¶ 4.

Applicants' evidence shows that Gilsonite oil was commercially available to the public at large at least as early as January 2000. Fisher Declaration, p 5.

The rejection fails to rebut applicants' evidence, and thus fails to establish a prima facie case of obviousness. Likewise, the Official Action fails to support its suggestion that the instant specification somehow supports the assertion that Gilsonite, Gilsonite oil, and Gilsonite in mineral oil are all the same. This is simply not true, and no fair reading of the specification supports the contention. The Advisory Action references page 9, lines 20-24 of the specification, however, that section is the "Brief Description of the Drawings", and does not support in any way the assertion. Indeed, there is no text beyond line 20 of p. 9 of the instant specification.

While there is a discussion of Gilsonite oil at page 14 of the specification, it does not support the assertion. There, applicants have indeed acknowledged that there are various grades of Gilsonite oil, and that they vary in color and viscosity; but that is not to say that they are the same thing as Gilsonite suspended in mineral oil. Neither the specification, nor any other cited reference, supports such a contention.

Further, nothing in the Advisory Action refutes the specification where applicants state: "The available Gilsonite oils can be selected for use in this invention

by one skilled in the art of drug formulation following the teachings and disclosure herein." Specification, p. 14, lines 24-25.

Neither the Advisory Action nor the earlier Official Action establishes a prima facie case of obviousness. Applicants respectfully request continued examination, reconsideration, and withdrawal of the rejection.

Although Applicants' have relied upon a series of references and resources from publicly available internet sites, Applicants do not suggest or concede that any of those materials or references constitute prior art. Of the foregoing, the only reference that might be deemed properly to be prior art, is the definition of Gilsonite found in "Academic Press Dictionary of Science and Technology."

In view of the foregoing remarks, Applicants respectfully request reconsideration and withdrawal of all outstanding rejections. Applicants submit that the claims are now in condition for allowance, and respectfully request formal notification to that effect. If, however, the Examiner perceives any impediments to such a notice of allowability, whether substantive or formal, the Examiner is encouraged to call Applicant's attorney at the number provided below. Such informal communication will expedite examination and disposition of this case.

Respectfully submitted,

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